

13/Reply
Brief
11/30/98
C. McKinney

PATENT
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
Re: APPEAL TO THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicant : Andrew E. Meyer et al. Art Unit: 2109
Serial No.: 08/821,760 Examiner: H. Sough
Filed : March 20, 1997
Title : VISUAL LATCHING INDICATOR FOR AN
ELECTRICAL BUSHING AND TERMINATOR

Commissioner of Patents and Trademarks
Washington, DC 20231

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REPLY BRIEF

GROUP 2100

Appellant presents this Brief in reply to the Examiner's Answer dated September 24, 1998. Appellant urges the reversal of the rejection of claims 13, 19 and 20 as being obvious over Eley in view of Laipply for two additional reasons: (1) Laipply is non-analogous art that cannot properly be relied upon by the Examiner, and (2) one of ordinary skill in the art would have had no motivation to combine Eley and Laipply. The Examiner's assertions to the contrary constitute impermissible hindsight reconstruction of the invention.

Eley is directed to an electrical bushing and terminator having basic elements similar to those recited in the claims. As noted by Eley, such bushings typically are used to connect high-voltage electrical cables to electrical equipment such as distribution transformers and electrical switches. See Eley at col. 1, lines 10-28. An operator typically attaches the terminator to the bushing using a hand-held stick that, for

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safety reasons, permits the operator to make the attachment while standing three to five feet away from the electrical equipment. See Eley at col. 1, lines 22-28 and the application at page 2, lines 1-10.

By contrast, Laipply is directed to a tube connector used to convey fluids -- a technical field wholly unrelated to electricity in general and to bushings in particular. As noted by Laipply, such tube connectors are used in the automotive field to connect flexible tubes for fuel lines, air conditioners, and the like. See Laipply at col. 1, lines 6-8. Laipply's connectors can be connected without the use of tools. See Laipply at col. 1, lines 16-18. Laipply teaches coloring the base of a groove defined in a sleeve of one of the tube connectors to permit an operator to quickly discern whether the connectors are fully coupled.

Laipply's tube connectors have no express or implied relationship to high voltage electrical components such as the terminator and bushing arrangements described by Eley and recited in the claims on appeal. As a result, Laipply is non-analogous art that cannot properly be relied upon in rejecting the claims under section 103. By statute, only those references that are within "the art to which [the claimed] subject matter pertains" may properly be relied upon in making an obviousness rejection. 35 USC 103(a). The Examiner ignored this statutory mandate in rejecting the claims.

Simply because Eley and Laipply both are directed to "connectors" is insufficient to make them analogous art. See In re Oetiker, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992) (reversing finding that connectors for garments were analogous art to an invention concerning a pre-assembly hook connector for an assembly line metal hose clamp).

Rather, to constitute analogous art, a reference either must be from the same field of endeavor, regardless of the problem addressed, or, if not from the same field of endeavor, must be reasonably pertinent to the particular problem with which the inventor is involved. See In re Clay, 966 F.2d 656, 23 USPQ2d 1058 (Fed. Cir. 1992). Laipply's field of endeavor (flexible tube connectors for fluids) is not the same as that of the invention (high voltage connectors for electricity). For example, flexible tube connector designers typically will have a background in mechanical engineering while high voltage electrical connector designers typically will have a background in electrical engineering. This difference between the fields of endeavor is further evidenced by the substantially different classifications applied by the Patent and Trademark Office to Eley and Laipply, and the lack of overlap in their fields of search. Cf. In re Deminski, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986) (noting that similar PTO classifications may be evidence of analogous art).

Nor would Laipply have been pertinent to the problem with which the present inventors were concerned. That problem

may be broadly stated as seeking to ensure electrical connectivity between electrical components even though the person making the connection by necessity must be positioned a substantial distance (e.g., three to five feet) from the components. Laipply would not have been pertinent to the problem faced by the present inventors. In particular, the present inventors, who were concerned with ensuring the integrity of high voltage, electrical connections, would not have looked to references, such as Laipply, dealing with flexible tube connectors designed for leak-free plumbing. Laipply's fundamental incompatibility with the claimed invention is demonstrated, for example, by Laipply's description of a sleeve and ring arrangement that, because it is installed by hand and without tools, would be extremely dangerous and entirely unsuited for high-voltage electrical applications, which typically require an operator to manipulate the components using a hot stick from a distance of three to five feet.

Moreover, Laipply's described use of color at the bottom of a groove would be difficult, if not impossible, to see from the distances at which the claimed electrical components are manipulated. Thus, the inventors could not logically have been expected to look to Laipply as a solution to the problem. See In re Clay, 23 USPQ2d at 1061 ("A reference is reasonably pertinent if . . . it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering the problem.").

For the sake of argument, even if Laipply properly could be treated as analogous art, the section 103 rejection is defective nevertheless because the art of record contains no suggestion or motivation to combine Eley and Laipply in the manner asserted by the Examiner. As the Federal Circuit has repeatedly explained, "[o]bviousness cannot be established by combining the teachings of prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." ACS Hosp. Sys. v. Montefiore Hosp., 732 F.2d 1572 (Fed. Cir. 1984). It is well settled that the Examiner cannot use appellants' own disclosure as the requisite suggestion for combining references. See, e.g., Interconnect Planning Corp. v. Feil, 774 F.2d 1132 (Fed. Cir. 1985) (when prior art references require selective combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight obtained from the invention itself); Sensonics, Inc. v. Aerosonic Corp., 81 F.3d 1566 (Fed. Cir. 1996) ("To draw on hindsight knowledge of the patented invention, when the prior art does not contain or suggest that knowledge, is to use the invention as a template for its own reconstruction -- an illogical and inappropriate process by which to determine patentability.") (citations omitted). Yet it appears that this is exactly what the Examiner has done.

Specifically, the motivation advanced by the Examiner for combining Eley and Laipply is that the combination would have been obvious "to enhance the detection of the incomplete

engagement of the connector terminals." Examiner's Answer at page 4, last four lines of first full paragraph. However, neither Eley nor Laipply so much as recognize that incomplete engagement of high voltage electrical connections is a problem. See In re Zurko, 111 F.3d 887, 42 USPQ2d 1476 (Fed. Cir. 1997) ("To say that the missing step comes from the nature of the problem to be solved begs the question because the Board has failed to show that this problem had been previously identified anywhere in the prior art.")

Eley states merely that an operator can use a hot stick tool to forcibly urge a male contact pin of an electrical connector into or out of electrical engagement with a corresponding female contact located in a bushing. See Eley at col. 1, lines 24-28. Laipply is concerned with ensuring that a sleeve-and-ring tube connection structure is engaged, and is motivated by the need to prevent leakage in fluid conduits. See Laipply at col. 1, lines 12-15. Neither reference relates to ensuring electrical connectivity in general or in providing an indication of such connectivity by using a color band formed flush on an outer circumferential surface of a bushing tongue as recited in the claims on appeal.

Accordingly, because the Examiner has failed to identify a legitimate suggestion in the prior art to combine Eley and Laipply, the section 103 rejection of the claims is defective and must be withdrawn for this additional, independent reason. See In re Rouffet, 47 USPQ2d 1453, 1458 (Fed. Cir. 1998)

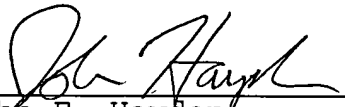
(reversing an obviousness determination based on a combination of references where the Board failed to identify any motivation to choose the references for combination: "Because the Board did not explain the specific understanding or principle within the knowledge of a skilled artisan that would motivate one with no knowledge of Rouffet's invention to make the combination, this court infers that the examiner selected those references with the assistance of hindsight.").

In view of the foregoing, appellant requests reversal of the appealed rejection.

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Respectfully submitted,

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